

## **REMARKS**

This paper is presented in response to the Office Action. No claims are canceled, amended, or added by this paper. Claims 19-29 were canceled in a previous paper. Claims 1-18 and 30-34 remain pending.

Reconsideration of the application is respectfully requested in view of the following remarks. For the convenience and reference of the Examiner, the remarks of the Applicant are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

Applicant notes that the remarks, or a lack of remarks, set forth herein are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

### **II. Claim Rejections Under 35 U.S.C. § 102(b)**

Applicant notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *See MPEP § 2131.*

At the outset, Applicant notes that while the Examiner has referred to “claims 1-34” as being rejected, claims 19-29 are no longer pending in the application.

With particular reference now to the rejection of claims 1-18 and 30-34, the Examiner has rejected those claims as “... being clearly anticipated by Gilliland et al. (USP NO. 6,283,644) [*Gilliland*].” However, the Examiner has provided no discussion whatsoever of *Gilliland*, or any other reference(s), in connection with this rejection. Moreover, the figure apparently intended by the Examiner to provide support for the rejection is actually Figure 6 from US 6,328,482 to Jian (“*Jian*”) and is not from *Gilliland*. Applicant notes that the Examiner has provided no discussion concerning Figure 6 of *Jian* in connection with the rejection under 35 U.S.C. § 102(b).

In light of the foregoing, Applicant respectfully submits that the Examiner has failed to establish that claims 1-18 and 30-34 are anticipated, at least because the Examiner has failed to show that each and every element as set forth in the claims is found in *Gilliland* or any other reference, and because the Examiner

has failed to show that the identical invention is shown in *Gilliland* or any other reference in as complete detail as is contained in the claims. Applicant thus respectfully submits that the rejection of claims 1-18 and 30-34 should be withdrawn.

### **III. Rejection of Claims Under 35 U.S.C. § 103(a)**

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

The Examiner has rejected claims 1-18 and 30-34 under 35 U.S.C. § 103(a) as being unpatentable over GB 2 241 349A to Adrian Jansen ("*Jansen*") or US 6,674,941 to Tatum et al. ("*Tatum*") in view of *Jian*. Applicant respectfully disagrees.

#### **a. rejection based on *Jansen* and *Jian***

Turning first to the rejection based on *Jansen* and *Jian*, the Examiner has stated that "*Jansen* ... disclose an optical fiber coupler comprising: An optoelectronic element coupled to the optical package for transmitting an optical signal and a fiber stop, which is made of plastic, & glass and the fiber stop is a spherical, ball, aspherical lens." This rejection is problematic for a variety of reasons.

For example, the Examiner has failed to provide even a single citation from *Jansen* in support of the rejection. Instead, the rejection made by the Examiner relies on nothing more than a conclusory assertion concerning the purported disclosure of *Jansen*. Thus, Applicant is left to guess at the position of the Examiner concerning the relation between specific elements of *Jansen* and the rejected claims. This much, Applicant declines to do, at least because the burden of establishing anticipation is on the Examiner.

Moreover, the Examiner has failed to assert, much less establish, that *Jansen* discloses all the limitations of the rejected claims. For example, claim 1 requires, among other things, "a receiving structure" and "a fiber stop attached to said receiving structure." Yet, the Examiner has failed to even assert that *Jansen* discloses these limitations, much less establish that *Jansen* does so. As another example, claim 30 requires, among other things, a "sleeve" and "a window situated at a first end of said sleeve." Again, however, the Examiner has failed to even assert that *Jansen* discloses these limitations, much less establish that *Jansen* does so. Thus, the rejection posed by the Examiner fails to address the actual language of the rejected claims.

**b. rejection based on *Jansen* and *Tatum***

Turning now to the rejection based on *Jansen* and *Tatum*, the Examiner has stated that “*Tatum* ... discloses an optical assembly for transferring light between an optoelectronic device and an optical fiber comprising: a housing of plastic material adapted to position the face of optical fiber, a lens and the optoelectronic converter (i.e., laser), a lens of plastic material positioned in housing between the face of the optical fiber and the optoelectronic converter, the lens having a first surface adapted to focus light on the optoelectronic converter and to substantially collimate light through lens, the lens having a second surface adapted to focus light in a range of distance along the common axis which is adjacent to the face of the optical fiber ...” As with the rejection based on *Jansen* and *Jian*, this rejection is problematic.

For example, the Examiner has failed to provide even a single citation from *Tatum* in support of the rejection. Instead, the rejection made by the Examiner relies on nothing more than a conclusory assertion concerning the purported disclosure of *Tatum*. Thus, Applicant is left to guess at the position of the Examiner concerning the relation between specific elements of *Tatum* and the rejected claims. This much, Applicant declines to do, at least because the burden of establishing anticipation is on the Examiner.

Moreover, the Examiner has failed to assert, much less establish, that *Tatum* discloses all the limitations of the rejected claims. For example, claim 1 requires, among other things, “a receiving structure” and “a fiber stop attached to said receiving structure.” Yet, the Examiner has failed to even assert that *Tatum* discloses these limitations, much less establish that *Tatum* does so. As another example, claim 30 requires, among other things, a “sleeve” and “a window situated at a first end of said sleeve.” Again, however, the Examiner has failed to even assert that *Tatum* discloses these limitations, much less establish that *Tatum* does so. Thus, the rejection posed by the Examiner fails to address the actual language of the rejected claims.

As well, Applicant notes that the rejection posed by the Examiner refers to various limitations that are not recited in any of the pending claims. For example, the Examiner has asserted that *Tatum* discloses “a housing adapted to position the face of optical fiber, a lens and the optoelectronic converter (i.e., laser).” Putting aside the question of whether this characterization advanced by the Examiner has any merit, none of the pending claims recites such a “housing.” As another example, the Examiner has asserted that *Tatum* discloses “... the lens having a first surface adapted to focus light on the optoelectronic converter and to substantially collimate light through lens, the lens having a second surface adapted to focus light in a range of distance along the common axis which is adjacent to the face of the optical fiber ...” Again however, none of the pending claims recites such a “lens.”

**c. purportedly obvious combination of *Jian* with *Jansen* or *Tatum***

In rejecting claims 1-18 and 30-34, the Examiner has asserted that “Jansen and Tatum et al differs from the claimed invention because he does not explicitly disclose fiber stop (i.e., lens) has an index of refraction approximately the same as the index of refraction of a core of the optical fiber as claimed. Since the light is transmitted from the fiber through the lens, the refractive index of the lens must be close to the refractive index of the fiber for optimum efficiency.”

In connection with the foregoing, Applicant notes that it appears that the Examiner is relying on personal knowledge as a basis for rejecting claims 1-18 and 30-34. Particularly, the Examiner has stated that “Since the light is transmitted from the fiber through the lens, the refractive index of the lens must be close to the refractive index of the fiber for optimum efficiency” (emphasis added), and the Examiner has not identified any references or other materials as providing support for this assertion. In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that: (i) specifically identifies any and all reference(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claims 1-34 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 1-34.

In what appears to be an allegation of motivation for the purportedly obvious modification of the *Jian* device with the purported disclosure of *Jansen* or *Tatum*, the Examiner has asserted, as noted above, that “the refractive index of the lens must be close to the refractive index of the fiber for optimum efficiency.” *Emphasis added.* Applicant notes however that “*optimum* efficiency” is a relative term whose definition is known only to the Examiner. For example, it is not apparent what reference point(s) the Examiner is using as a basis to assert that such efficiency would be optimized as a result of the implementation of the purportedly obvious combination. Accordingly, the ability of the Applicant to respond to the allegations made by the Examiner is at least somewhat compromised.

With continued attention to the purported motivation to combine *Jian* with *Jansen* or *Tatum*, the Examiner has asserted that “it would have been obvious ... to modify the optical assembly of Jansen or Tatum et al. in view of Jian since lens and the optical fiber can be made of plastic material and index of refraction can be similar in Jansen or Tatum et al.” *Emphasis added.* Applicant respectfully disagrees with this assertion and notes that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art, if it is such, also suggests the desirability of the combination. See, e.g., *MPEP* § 2143.01.

Further, while the Examiner has alleged that “it would have been obvious ... to modify the optical assembly of Jansen or Tatum,” the Examiner has failed to establish that either the *Jansen* or *Tatum* device suffers from such shortcomings as could, or would, be remedied by use of the purported disclosure of *Jian*. In the absence of any evidence that either the *Jansen* or *Tatum* device is somehow deficient in terms of their respective performance, or other, characteristics, Applicant submits that the Examiner has failed to establish existence of the requisite motivation to make the purportedly obvious combination.

With continuing reference to the purportedly obvious combination of *Jian* with *Jansen* or *Tatum*, the Examiner has also alleged that “it would have been obvious under 013 to use the similar index of refraction as taught by Jansen or Tatum et al. with the *Jian* since, with both device being directed to a common use in the same environment, there is an implied suggestion for applying the teachings of one to the other. That is, skilled worker who is pressured to have knowledge of the prior art, with these references before him, would immediately recognize the desirability of using such teachings taught by Jansen or Tatum et al to the device of *Jian*, as claimed.”

At the outset, Applicant is unclear as to what is meant by the statement of the Examiner that “it would have been obvious under 013 to use the similar index of refraction as taught by Jansen or Tatum et al. with the *Jian* ...” *Emphasis added*. Accordingly, Applicant respectfully requests that the Examiner provide suitable clarification on this point. Applicant notes further that it appears from the foregoing assertion that the Examiner is taking the position that it would be obvious to modify the *Jian* device with the purported disclosure of either *Jansen* or *Tatum*. However, that position is inconsistent with the position set forth at paragraph 15. of the Office Action where, instead, the Examiner alleged it would be obvious to modify the *Jansen* or *Tatum* device with the purported disclosure of *Jian*. In light of this apparent contradiction in positions advanced by the Examiner, it is not presently clear to Applicant as to precisely what the position of the Examiner is with respect to the purported obviousness of combining the teachings of *Jansen* or *Tatum* with those of *Jian*. Accordingly, Applicant respectfully requests that the Examiner provide suitable clarification on this point.

Turning now to the substance of the allegation by the Examiner that it would be obvious to modify the *Jian* device with the purported disclosure of either *Jansen* or *Tatum*, Applicant notes that while the Examiner has asserted that *Jansen* and *Tatum* teach “the similar index of refraction” (Office Action at ¶ 17), the Examiner has conceded elsewhere in the Office Action that Jansen and Tatum fail in this regard. Particularly, the Examiner has admitted that “Jansen and Tatum et al differs from the claimed invention because he does not explicitly disclose fiber stop (i.e., lens) has an index of refraction approximately the same as the index of refraction of a core of the optical fiber as claimed ...” *Emphasis added*. In view of this admission by the Examiner, the assertion of the Examiner that “it would have been

obvious under 013 to use the similar index of refraction as taught by Jansen or Tatum et al. with the Jian ...” (emphasis added) is not well taken.

As noted above, one apparent rationale advanced by the Examiner for the purportedly obvious modification of the *Jian* device with the purported disclosure of either *Jansen* or *Tatum* is that “... with both device being directed to a common use in the same environment, there is an implied suggestion for applying the teachings of one to the other.” Applicant disagrees. At the outset, Applicant notes that the Examiner has not cited any portion of any of the cited references in support of the allegation that the *Jansen* and *Tatum* devices are “directed to a common use in the same environment.” In any event, the mere fact that two devices are “directed to a common use in the same environment” is, without more, simply inadequate to establish the existence of a suggestion or motivation to combine reference teachings. As to the contention of the Examiner that “... a skilled worker ... would immediately recognize the desirability of using such teachings taught by Jansen or Tatum et al to the device of Jian ...,” Applicant respectfully submits that such contention is nothing more than a conclusory allegation by the Examiner, inasmuch as the Examiner has failed to identify anything from the references that would suggest, implicitly or otherwise, the desirability of the purportedly obvious combination.

Continuing, the Examiner has alleged that “... applicant has not described this limitation (similar index of refraction of lens and optical fiber” as being critical or as yielding unexpected benefits. Certainly a person of ordinary skill in the art would find it beneficial to minimize back reflections.” It appears that in making this allegation however, the Examiner is improperly attempting to place a burden on the Applicant to establish patentability (such as by making assertions as to the criticality of certain claim elements) of the claims. It is well established, however, that the burden is on the Examiner to make a *prima facie* case that the claims are not patentable. Applicant notes, moreover, that the lack of such description by the Applicant is simply inadequate to serve as a foundation for a conclusion of obviousness. Applying the rationale advanced by the Examiner, an applicant could inoculate claims from a charge of obviousness merely by including self-serving statements of the criticality of particular limitations in the application. Such an approach however has no basis in logic or fact.

As well, Applicant notes that it appears that the Examiner is relying on personal knowledge as a basis for rejecting claims 1-18 and 30-34. Particularly, the Examiner has stated that “Certainly a person of ordinary skill in the art would find it beneficial to minimize back reflections,” and the Examiner has not identified any references or other materials as providing support for this assertion. In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that: (i) specifically identifies any and all reference(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claims 1-18 and 30-34 is

based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 1-18 and 30-34.

Finally, it was noted above that the Examiner has alleged that “Certainly a person of ordinary skill in the art would find it beneficial to minimize back reflections.” *Emphasis added*. However, the Examiner has not established that any of the disclosed devices are deficient in terms of their performance with regard to back reflections. Thus, it is not clear why one of skill in the art would be inclined to make the purportedly obvious modification. Moreover, Applicant notes that “minimize back reflections” is a relative term whose definition is known only to the Examiner. For example, it is not apparent what reference point(s) the Examiner is using as a basis to assert that such minimization would be achieved as a result of the implementation of the purportedly obvious combination. Accordingly, the ability of the Applicant to respond to the allegations made by the Examiner is at least somewhat compromised.

**d. purported obviousness of claims 1-18 and 30-34**

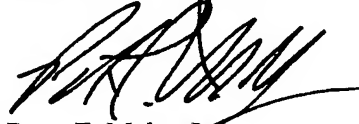
As the discussion set forth at III.a.-c. above makes clear, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1-18 and 30-34, at least because the Examiner has failed to establish the existence of a suggestion or motivation to make the purportedly obvious combination, and because the Examiner has not established that the references, when combined in the purportedly obvious fashion, teach or suggest all the limitations of the rejected claims. Applicant thus respectfully submits that the rejection of claims 1-18 and 30-34 should be withdrawn.

**CONCLUSION**

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-34 is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 12<sup>TH</sup> day of April, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "P. F. Malen, Jr.", written over a horizontal line.

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